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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,429	10/28/2003	David Mathieu	AUC-32815-1	9460
56080 7590 08/27/2008 WHYTE HIRSCHBOECK DUDEK S.C. 33 East Main Street, Suite 300 Madison, WI 53703-4655				
EXAMINER				
NGUYEN, PHONG H				
ART UNIT		PAPER NUMBER		
3724				
MAIL DATE		DELIVERY MODE		
08/27/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/695,429

**Applicant(s)**

MATHIEU ET AL

**Examiner**

PHONG H. NGUYEN

**Art Unit**

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 May 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.  
4a) Of the above claim(s) 1-18, 23, 26 and 28-35 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 19-22, 24, 25, 27 and 36-39 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.84 (b)(1) since there are some photographs in the drawing section. Photographs, including photocopies of photographs, are not ordinarily permitted in utility and design patent applications. The Office will accept photographs in utility and design patent applications, however, if photographs are the only practicable medium for illustrating the claimed invention. For example, photographs or photomicrographs of: electrophoresis gels, blots (e.g., immunological, western, Southern, and northern), auto-radiographs, cell cultures (stained and unstained), histological tissue cross sections (stained and unstained), animals, plants, in vivo imaging, thin layer chromatography plates, crystalline structures, and, in a design patent application, ornamental effects, are acceptable.

### ***Specification***

2. The Specification is objected to under 37 CFR 1.71 because it does not describe the mechanical structure of the actuator that allows the actuator to move the cutting blade into a cutting position or a non-cutting position. The Specification only describes the actuator of the non-elected species in Figs. 2-6. It does not seem that the actuator of the non-elected species in Figs. 4-6 can be used in the elected Species in Fig. 1.

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3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 21, 22 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 21, 22 and 27, it is unclear how the actuator in the rotary trimmer in Fig. 1 can move the cutting blade into a cutting position or a non-cutting position. It is to be noted that Fig. 1 does not show any actuator. There is no indication that the actuator in the non-elected species can be bodily incorporated into the rotary trimmer in Fig. 1. For example, the actuator 28 of the non-elected species in Fig. 4 is provided in the midsection of the elongated handle 22. A user wraps his finger around the handle 22 and uses his index finger to squeeze the actuator 28. If the actuator 28 of the non-elected species in Fig. 4 is incorporated into the elected species in Fig. 1, a user cannot wrap his finger around the handle 22 and use his index finger to squeeze the actuator 28. Therefore, the actuator in Fig. 4 does not work in the rotary trimmer in Fig. 1.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 19-22, 24, 27 and 36-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 19-22, 24, 27 and 36-39, it is unclear how an actuator in the rotary trimmer in Fig. 1 can move the cutting blade into a cutting position or a non-cutting position.

Claim 27 calls for the actuator 28 interacting with the fastener 43. It is unclear how the interaction between the actuator 28 and the fastener 43 can happen since the actuator 28 and the fastener 43 appears to be spaced apart.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 19-22, 24, 25, 27 and 36-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Brening (957,409).

Regarding claim 19, Brening teaches a rotary trimmer comprising a blade carriage (a), a blade guard assembly (a2) having a cutting blade (b) indirectly secured to the blade guard, and a blade guard assembly fastener (the screw on the right side in Fig. 2) for removably connecting the blade guard assembly to the blade carriage. See Figs. 1-4.

Regarding claim 20, the handle (a10) being an arcuate pad is best seen in Figs. 1-2.

Regarding claim 21, an actuator (a6, a4 and a1) that selectively positions the cutting blade between an operative position and an inoperative position is best seen in Figs. 1-2.

Regarding claim 22, the actuator (a6, a4 and a1) slidably positioning the cutting blade is best seen in Fig. 1.

Regarding claim 24, a clip is the screw that secures the blade to the blade guard assembly. See Fig. 2.

Regarding claim 25, a handle (a10) of the blade carriage is best seen in Figs. 1-2.

Regarding claim 27, the blade guard assembly fastener located on element (a) and element (a) moves up or down due to the actuator (a6, a4 and a1). Therefore, the blade guard assembly fastener is considered indirectly interacting with the actuator.

Regarding claim 36, Brening teaches a rotary trimmer comprising a cutting blade (b), a blade guard assembly (a) having a cutting blade secured thereto, and a blade carriage (a2) for carrying the blade guard assembly. See Fig. 1-4.

Regarding claim 37, the rotary trimmer being connected to a cutting board having a rail is best seen in Fig. 4.

Regarding claim 38, Brening teaches a rotary trimmer comprising a blade carriage (a2), a fastener (the screw on the right side in Fig. 2) situated on the blade carriage, a blade guard assembly (a) having a cutting blade secured thereto, and an actuator (a10) for moving the cutting blade (b) between an operative position and an inoperative position,

wherein the blade guard assembly is readily removed from the blade carriage. See Figs. 1-4.

9. Claim 39 is rejected under 35 U.S.C. 102(b) as being anticipated by Boda et al. (5,299,355), hereinafter Boda.

Boda teaches a rotary trimmer comprising a blade carriage (42), a fastener (18) situated on the blade carriage, a cutting blade (14) received on the fastener (18), a guard (60) covering the cutting blade and secured to the cutting blade, and a handle (12) on the blade carriage. See Fig. 3.

It is to be noted that the cutting blade 14 and the guard 60 are connected by a fastener 18 to form a single integral blade guard assembly.

10. Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Ridgely (909,227).

Ridgely teaches a rotary trimmer comprising a blade carriage (1), a blade guard assembly (13 and 19) having a cutting blade (26) secured to the blade guard, and a blade guard assembly fastener (4) for removably connecting the blade guard assembly to the blade carriage. See Figs. 1-4.

#### ***Response to Arguments***

11. Applicant's arguments filed on 05/29/2008 have been fully considered but they are not persuasive.

Regarding the objection to the drawing, the Office does not ordinarily accept photocopies of photographs in a utility patent. Therefore, the Applicant must provide formal replacement drawings.

Applicant's argument with respect to the objection to the specification and the rejection under 112, 2<sup>nd</sup> paragraph is not persuasive. The Applicant has elected the species in Fig. 1 for examination. Therefore, examination process is based on the teaching of the species in Fig. 1. However, nowhere in Figs. 1 and 2 shows an actuator. Fig. 3 does show an actuator. However, the disclosure does not teach whether the species in Fig. 1 can have the actuator in Fig. 3. Furthermore, it appears that the actuator in Fig. 3 cannot be structurally incorporated into the species in Fig. 1.

Applicant argument with respect to the rejection of claim 19 and 20 under 35 USC 112, 2nd paragraph is persuasive. The rejection of claim 19 and 20 under 35 USC 112, 2nd paragraph is withdrawn.

Regarding the Applicant's argument with respect to the rejection of claim 19 under Brenning, the Applicant argue that Brenning does not teach a blade guard (a2) including a blade and the blade being secured to a blade guard. This argument is not persuasive. The blade guard assembly (a2) and the blade carriage (a) firmly hold the blade (b) in place. Therefore, the blade guard assembly (a2) is considered to be secured to the blade guard assembly. The Applicant needs to provide more detail of a structure that physically fastens the blade to the blade guard in order to overcome Brenning.

Regarding the Applicant's argument with respect to the rejection of claim 19 under Ridgely, the Applicant argues that the blade carriage must have a mounting



structure for receiving a cutting blade. This argument is not persuasive. The limitation of the blade carriage having a mounting structure for receiving a cutting blade is not in claim 19. It appears that the Applicant tries to import limitations in the Specification into the claim. Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment. *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004).

Regarding the Applicant's argument with respect to the rejection of claim 39 under *Boda*, since the Applicant considers a single cutting blade and a single blade guard connected together by a fastener as an single integral blade guard assembly, the Examiners considers a single cutting blade 14 and a single blade guard 60 connected together by a fastener 18 as an single integral blade guard assembly.

#### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHONG H. NGUYEN whose telephone number is (571)272-4510. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Timothy V Eley/  
Primary Examiner, Art Unit 3724

/P. H. N./  
Examiner, Art Unit 3724  
August 22, 2008